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03/14/1995 10/22/90 DORFMAN

M 208260

EXAMINER

1252 10231

ART UNIT

PAPER NUMBER

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203 WEST FIFTH STREET  
ST. LOUIS, MO 63102  
100 ANCELLS, CA 95071-2066

1204

DATE MAILED: 02/21/95

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☐ Responsive to communication filed on 09 Nov. 94 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire Three month(s), \_\_\_\_\_ days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- ☐ Notice of References Cited by Examiner, PTO-892.
- ☐ Notice of Draftsman's Patent Drawing Review, PTO-948.
- ☐ Notice of Art Cited by Applicant, PTO-1449.
- ☐ Notice of Informal Patent Application, PTO-152.
- ☐ Information on How to Effect Drawing Changes, PTO-1474.
- ☐ \_\_\_\_\_

Part II SUMMARY OF ACTION

- ☐ Claims 1-44 are pending in the application.  
Of the above, claims 6-13 are withdrawn from consideration.
- ☐ Claims \_\_\_\_\_ have been cancelled.
- ☐ Claims \_\_\_\_\_ are allowed.
- ☐ Claims 1-7 and 14-44 are rejected.
- ☐ Claims \_\_\_\_\_ are objected to.
- ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.
- ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
- ☐ Formal drawings are required in response to this Office action.
- ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
- ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
- ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved; ☐ disapproved (see explanation).
- ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.
- ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
- ☐ Other

EXAMINER'S ACTION

Art Unit 1204

This is in response to the communication filed 09 Nov. 1994.

The claims are 1-44.

In response to the restriction/election requirement applicants elected the species recited on page 13, lines 28-31, p[3,5,5,8,8-pentamethyl-1,2,3,4-tetrahydro-2-naphthyl-(2 methano)]-benzoic acid. Claims 1-7 and 14-44 read on the elected species.

Claims 1-3 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are overly broad, indefinite, and <sup>cover</sup> ~~over~~ more territory than the specification could possibly support. The term "a ligand" without specifically defining the ligand is overly broad.

Claims 1-3 are provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 1-4 of copending application Serial No. 141,914 or 141,246. This is a *provisional* double patenting rejection since the conflicting claims have not in fact been patented.

Art Unit 1204

Claims 14-32 are rejected under 35 U.S.C. § 112, fourth paragraph, as being of improper dependent form for failing to further limit the subject matter of a previous claim. There is no recitation of pharmaceutical composition or method of use in the independent claims.

Claims 33, 34, 35, 36, 37, 38-44 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims as they now stand are unspecific and embrace a wider spectrum of compounds than the specification could possibly support. The claims should be limited to what is actually supported by the specification.


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Serial No. 08/141,496

-4-

Art Unit 1204

Any inquiry concerning this communication should be directed to  
Examiner Killos at telephone number (703) 308-0135.

  
PAUL J. KILLOS  
PRIMARY EXAMINER  
ART UNIT 1204  
1/14

Killos: aco  
February 13, 1995